



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,229	11/06/2001	Chisato Hirata	ACE-1001	5572

7590

12/02/2005

Mitchell P Brook  
Luce Forward Hamilton & Scripps  
11988 El Camino Real Suite 200  
San Diego, CA 92130

EXAMINER

MAI, TRI M

ART UNIT PAPER NUMBER

3727

DATE MAILED: 12/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

TKM

<b>Office Action Summary</b>	<b>Application No.</b> 10/009,229	<b>Applicant(s)</b> HIRATA, CHISATO	
	<b>Examiner</b> Tri M. Mai	<b>Art Unit</b> 3727	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 13-17 and 19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-17 and 19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/26/05</u> | 6) <input type="checkbox"/> Other: ____  |

### **DETAILED ACTION**

1. This Office Action is responsive to amendment dated 12/30/04. The amendment dated 02/08/05 has not been entered. The previous Office Action is withdrawn.
2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the thicker portion must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. Claims 13-17, and 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the

Art Unit: 3727

relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The original disclosure does not teach the curved side of the elliptical cross section is thicker than the remaining portion of the elliptical cross section. *This is a new matter rejection*

During the telephone interview dated 11/15/05. Applicant asserts that the gradual curved side of the elliptical cross section is inherently being thicker than the remaining portion.

Applicant asserts two US patents 4034036 (col. 1, ln. 23) and 4421711 (col. 1, ln. 45-51) inherently teach the elliptical cross section being thicker than the remaining portion. The examiner disagrees, i.e., the two patents, inter alias, do not teach a bottle with the ornamentation structure as claimed. Furthermore, the two cited patents lacks the specificities of **an inherent teaching** in the container as claimed.

4. Claims 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hager et al. (D419867) in view of Ota et al. (5238129) or Carew et al. (6044996). Hager teaches a container with a ornamental shape of a figurine shape of a animal. Hager meets all claimed limitations except for the cap, and the base portion is provided with decompression panels. Either of Ota Carew teaches that it is known in the art to provide a decompression panels. It would have been obvious to one of ordinary skill in the art to provide decompression panels in Hager as taught by either Ota or Carew to enable one to manufacture the bottle easily.

With respect to the elliptical cross section and the gradual curved portion. It is noted there is a gradual curved portion about the neck. Furthermore, it would have been obvious to one of ordinary skill in the art to provide a figurine with an elliptical cross section to provide the desired figurine for the container. Furthermore, It is noted that matter relating to ornamentation

Art Unit: 3727

only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. In re Seid, 161 F.2d 229, 73 USPQ 431 (CCPA 1947).

With respect to the cap, the container in Hager would inherently having a cap as claimed. To the degree it is argued that there is no cap in Hager, it would have been obvious to one of ordinary skill in the art to provide a cap to close the bottle.

Even to the degree that the elliptical cross section inherently has a thicker portion, it would have been obvious to one of ordinary skill in the art to make the container from blow molding method as taught by either Ota or Carew to manufacture the container easily. It is noted that blow molding would inherently would provide a thicker portion at the elliptical section as set forth.

5. Claims 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Becker (D187435) in view of Ota et al. or Carew et al.. Becker teaches a container with a ornamental shape of a figurine shape of a animal. Becker meets all claimed limitations except for the cap, and the base portion is provided with decompression panels. Either of Ota or Carew teaches that it is known in the art to provide a decompression panels. It would have been obvious to one of ordinary skill in the art to provide decompression panels in Hager as taught by either Ota or Carew to enable one to manufacture the bottle easily.

With respect to the cap, the container in Becker would inherently having a cap as claimed. To the degree it is argued that there is no cap in Becker, it would have been obvious to one of ordinary skill in the art to provide a cap to close the bottle.

With respect to the elliptical cross section and the gradual curved portion. It is noted there is a gradual curved portion about the neck. Furthermore, it would have been obvious to

Art Unit: 3727

one of ordinary skill in the art to provide a figurine with an elliptical cross section to provide the desired figurine for the container. Furthermore, It is noted that matter relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. In re Seid, 161 F.2d 229, 73 USPQ 431 (CCPA 1947).

6. Claims 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Ota et al. (5238129) or Carew et al. (6044996) in view of either Becker or Hager. It would have been obvious to one of ordinary skill in the art to provide the figurine on top of body portion in either Ota or Carew as taught by either Becker or Hager to attract consumer.

With respect to the cap, the container in either Ota or Carew would inherently having a cap as claimed. To the degree it is argued that there is no cap in Ota or Carew, it would have been obvious to one of ordinary skill in the art to provide a cap to close the bottle.

With respect to the elliptical cross section and the gradual curved portion. It is noted there is a gradual curved portion about the neck in either Becker or Hager. Furthermore, it would have been obvious to one of ordinary skill in the art to provide a figurine with an elliptical cross section to provide the desired figurine for the container. Furthermore, It is noted that matter relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. In re Seid, 161 F.2d 229, 73 USPQ 431 (CCPA 1947).

7. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over any of the rejections of Hager, Becker, Ota and Carew as set forth in paragraphs 2-4, and further in view of JP 952570. It would have been obvious to one of ordinary skill in the art to provide a cap in the shape of a hat as taught JP'570 to simulate the container.

Art Unit: 3727

8. Claims 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0879765. or in the alternative, over EP '765 in view of either Bonnebat et al. (4034036) or Farrell (4421711). EP '765 teaches a figurine in 5. It would have been obvious to one of ordinary skill in the art to provide a figurine with an elliptical cross section to provide the desired figurine for the container. Furthermore, It is noted that matter relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. In re Seid, 161 F.2d 229, 73 USPQ 431 (CCPA 1947).

Even to the degree that the elliptical cross section inherently has a thicker portion, it would have been obvious to one of ordinary skill in the art to make the container from blow molding method as taught by either Bonnebat or Farrell to manufacture the container easily. It is noted that blow molding would inherently would provide a thicker portion at the elliptical section as set forth.

9. Claims 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP '765 in view of either Ota or Carew. To the degree it is argued that EP '765 does not teach the recess portion being arcuate surface and the panels are rectangular. It would have been obvious to one of ordinary skill in the art to provide the decompression panels in either Ota or Carew to provide an alterative compression panels.

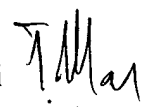
10. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP'765 rejection of as set forth above, and further in view of JP 952570 or Kolb (D192390). It would have been obvious to one of ordinary skill in the art to provide a cap in the shape of a hat as taught JP'570 or Kolb to simulate the container.

Art Unit: 3727

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tri M. Mai whose telephone number is (571)272-4541. The examiner can normally be reached on 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, <sup>Nathan Newhouse</sup> ~~Lee W. Young~~ can be reached on (571)272-<sup>4544</sup>~~4549~~. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tri M. Mai   
Primary Examiner  
Art Unit 3727